

**REMARKS**

This is a further response to the Final Action dated August 18, 2006 in the above-referenced patent application, filed in conjunction with an accompanying RCE. Claims 1-15 are pending in the above-referenced patent application. All of the claims were rejected. Specifically, claims 1-4, 6-8 were rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond (USPN 6,698,020). Claims 5, 12-13 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of U.S. Patent Application publication 20020010927 (Kim). Claims 9-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of U.S. Patent Application publication 20040073947 (Gupta), and further in view of Dimitrova (USPN 6,469,749). Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Kim, and further in view of Gupta and Dimitrova. Claims 1, 9, 12 and 14, have been amended to further clarify the claimed limitations in overcoming the rejections. Accordingly, the rejection of claims 1-15 is respectfully traversed because at least for the following reasons the references, alone or in combination, do not disclose all of the claimed limitations, as amended.

**Claim Rejections Under 35 U.S.C. 102(e)**

Rejection of claims 1-4, 6-8 under 35 U.S.C. 102(e) as being anticipated by Zigmond is respectfully traversed because Zigmond does not disclose all of the claimed limitations.

As per Claim 1, Zigmond does not disclose providing a digital television receiver performing a Digital TV function including receiving and outputting information, storing a plurality of advertisement messages in a storage device for later access, subsequently using the

digital television receiver to receive video data from a digital television service provider for subsequent output with the advertisement messages using the Digital TV function of the digital television receiver, accessing the stored advertisement messages in the storage device, arranging and outputting the plurality of the advertisement messages and the received video data with the digital television receiver, maintaining a count of the number of the plurality of the advertisement messages that has been output by the digital television receiver, and if a predetermined number of the plurality of the advertisement messages has been output by the digital television receiver, then disabling the digital TV function of the digital television receiver, as required by Claim 1.

It is respectfully submitted that element 60 in fig. 3 of Zigmond, col. 7, lines 37-67, is an AD insertion unit that inserts advertisements, not a digital television receiver performing a Digital TV function, as claimed. Further, it is respectfully submitted that element 84 in fig. 5 of Zigmond, col. 15, lines 17-34, is an AD filter that pre-screens and accepts only selected advertisements from an AD delivery source, does not store any ADs and does not perform: storing a plurality of advertisement messages in a storage device, as required by Claim 1. Further, it is respectfully submitted that element 62 in fig. 4 of Zigmond, col. 8, lines 1-11, is an AD source, not a storage device. Element 62 in Zigmond provides an advertisement stream to multiple households via channels from a central location, and does not perform storing a plurality of advertisement messages in a storage device, as required by Claim 1. Further, it is respectfully submitted that Element 66 in Zigmond, col. 8, lines 29-38; col. 7, lines 1-25, is simply a programming source, and does not disclose using the digital television receiver to receive video

data from a digital television service provider, subsequent to storing a plurality of the advertisement messages, as required by Claim 1.

Further, it is respectfully submitted that, element 58 in Zigmond, col. 8, lines 29-38, is a display monitor not a receiver for subsequent output using the Digital TV function of the digital television receiver. Further, in Zigmond, ADs and video programming are toggled. Therefore, Zigmond does not disclose: with the digital television receiver, outputting the plurality of the advertisement messages and the received video data, as required by Claim 1 (emphasis added).

Further, it is respectfully submitted that element 61 in Zigmond is a statistics collection location, and does not disclose: “if a predetermined number of the plurality of the advertisement messages has been output, then disabling the digital TV function of the digital television receiver,” as required by Claim 1. Indeed, in col. 13, lines 40-47, Zigmond states: “In one embodiment, statistics collection location 61 of FIG. 5 counts the number of times a particular viewer has seen a selected advertisement. Once the advertisement has been displayed the desired number of times during a given time period, further display of the advertisement to the viewer is blocked. This is useful, for example, to prevent viewers from becoming frustrated through being excessively exposed to the selected advertisement.” Therefore, in Zigmond in order to prevent user frustration, further display of advertisements to a viewer is blocked while display of regular video programming continues. By contrast, as claimed herein: “if a predetermined number of the plurality of the advertisement messages has been output, then disabling the digital TV function of the digital television receiver,” as claimed. Therefore, by contrast to Zigmond, according to the

claimed invention herein, if a predetermined number of the advertisement messages have been output, then the digital TV function of the digital television receiver is disabled such that unlike Zigmond regular video programming is disabled. For at least these reasons, it is respectfully submitted that rejection of Claim 1, and all claims dependent therefrom (claims 2-11), should be withdrawn.

As per Claim 2, it is respectfully submitted that Zigmond does not disclose: “after the digital TV function has been disabled, such that video data from the digital television service provider are no longer output, storing a new set of the plurality of advertisement messages in the storage device, and subsequently enabling the digital TV function of the digital television receiver” as required by Claim 2. It was discussed in relation to Claim 1 that Zigmond (col. 13, lines 40-47) does not disclose disabling output of regular programming to a viewer. Further, a careful reading of Zigmond (col. 8, lines 29-39), reveals that Zigmond only mentions that ADs and regular programs are toggled by a switch 68 for display. Therefore, Zigmond does not disclose: “storing a new set of the plurality of advertisement messages in the storage device, and subsequently enabling the digital TV function of the digital television receiver,” as required by Claim 2.

As per Claim 3, in col. 8, lines 29-37, Zigmond only mentions that ads and regular programs are toggled by a switch 68 for display. Zigmond does not disclose: “downloading the new set of the plurality of the advertisement messages from a network” and “storing the new set of the plurality of the advertisement messages in the storage device,” as claimed.

As per Claim 4, Zigmond, col. 14, lines 49-58, does not disclose: “setting the predetermined number such that all of the plurality of the advertisement messages that were stored will be output,” as required by Claim 4. In col. 14, lines 49-58, Zigmond only mentions that an advertiser may pay for a guaranteed number of exposures (which may be different for different advertisers). However, this does not teach setting the predetermined number such that all of the plurality of the advertisement messages that were stored will be output, as claimed.

As per Claim 6, Zigmond does not disclose: “providing the storage device as a component of the digital television receiver,” as required by Claim 6. Element 84 in fig. 5 of Zigmond (col. 15, lines 17-34) is an AD filter used to pre-screen and accept only selected advertisements from the ad delivery source. Element 84 does not store any ADs and does not provide a storage device as a component of the digital television receiver, as required by Claim 6. Further, element 62 in fig. 4 of Zigmond (col. 8, lines 1-11) is an AD source, not a storage device, that provides an advertisement stream to multiple households via channels from a central location. As such, does not disclose providing the storage device as a component of the digital television receiver, as required by Claim 6. Further, element 62 in fig. 4 of Zigmond is not part of the viewer’s TV set (i.e., element 62 is not: “the storage device as a component of the digital television receiver,” as claimed), rather an AD source external to the viewer’s location.

As per Claim 7, Zigmond does not disclose: “storing the plurality of the advertisement messages by downloading the plurality of the advertisement messages from a network,” as required by Claim 7. It is respectfully submitted that element 84 in fig. 5 of Zigmond (col. 15,

lines 17-34), is an AD filter used to pre-screen and accept only selected advertisements from the ad delivery source, and does not perform the plurality of the advertisement messages by downloading the plurality of the advertisement messages from a network, as required by Claim 6. Further, element 62 in fig. 4 of Zigmond (col. 8, lines 1-11), is an AD source. Element 62 in fig. 4 of Zigmond only provides an advertisement stream to multiple households via channels from a central location. This does not teach: “downloading the plurality of the advertisement messages from a network” and “storing the plurality of the advertisement messages,” as claimed.

As per Claim 8, Zigmond does not disclose: receiving additional video data from the digital television service provider; with the digital television receiver, outputting the additional video data without outputting the plurality of the advertisement messages; and limiting a duration that the step of outputting the additional video without outputting the plurality of the advertisement messages can be performed,” as claimed. In col. 18, line 38 - col. 19, line 9, relied on by the Examiner, it is respectfully submitted that Zigmond only mentions feeding cross-over links such an Internet link that may be related to a video program. However, feeding such cross-over links does not teach receiving additional video data from the digital television service provider, as claimed. Internet links or program descriptions are not video data. Zigmond does not disclose outputting the additional video data without outputting the plurality of the advertisement messages, as claimed. Further, it is respectfully submitted that Zigmond does not teach limiting a duration of outputting the additional video without outputting the plurality of the advertisement messages, as claimed. A change in program descriptions in Zigmond does not

teach limiting display duration of additional received video.

**Claim Rejections Under 35 U.S.C. 103(a)**

Rejection of Claims 5, 12-13 and 15 under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Kim is respectfully traversed because the references, alone or in combination, do not disclose all of the claimed limitations.

As per Claim 5, as discussed, Zigmond does not disclose all of the limitations of independent Claim 1. Further, in Kim the regular video and Banner information are transmitted to and are received, and displayed, at a receiver. However, as claimed herein the advertisement messages are in a storage device and the receiver receives video data from a service provider. , the references, alone or combination do not disclose: “performing the outputting step such that the plurality of the advertisement messages that were stored are output as banner advertisement messages together with the received video data,” as required by Claim 5. One of ordinary skill in the art will not look to combine the references as the Examiner suggests.

As per claim 12, Zigmond does disclose all of the claim limitations for at least the reasons provided in relation to Claim 1. Further, Zigmond, col. 6, lines 40-47, generally mentions a television sets and hardware for recording to access to the Internet. It is respectfully submitted that this does not disclose a video decoder for decoding received video bit streams of a selected program to obtain decoded video bit streams of the selected program, as claimed. Elements 83, 84 and 86 in Zigmond do not perform a banner rendering function for decoding and rendering the

stored data to obtain rendered data, as claimed.

Further, for reasons discussed in relation to Claim 1 Zigmond (element 61, or col. 13, lines 40-47) does not disclose: a banner manager unit for reading out the stored data from said banner storage device and for providing the stored data to said banner rendering unit, said banner manager unit generating a disable signal when a predetermined number of the advertisement messages, represented by the stored data, have been read out from the banner storage device, as claimed.

Further, ADs in Zigmond are not encoded to then require decoding. Zigmond does not even mention bit streams. In addition, for the reasons provided in relation to Claim 5, Kim and Zigmond, one of ordinary skill in the art will not look to combine the references as the Examiner suggests, and the references do not disclose an output terminal connected to said video reconstruction unit for receiving the combined video output signal and for outputting the combined video output signal, as claimed. For at least these reasons, it is respectfully submitted that rejection of Claim 12, and all claims dependent therefrom (claims 13-15), should be withdrawn.

Rejection of Claims 9-11 under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Gupta, and further in view of Dimitrova, is respectfully traversed because for at least for the following reasons the references, alone or in combination, do not disclose all of the claimed limitations. As per Claim 9, as discussed, Zigmond fails to teach all of the limitations of base



Claims 1 and 8. However, the Examiner states that Gupta and Dimitrova disclose such limitations, and that it would have been obvious to one of ordinary skill in the art to combine the references. Applicant respectfully traverses that Gupta and Dimitrova disclose the claimed limitations, and further traverses their combination. There is no suggestion from either reference that they be combined or modified as proposed by the Examiner. Further, the references teach away from the claimed invention.

It is respectfully submitted that Gupta [0074], [0078],[0085] (relied on by the Examiner), does not disclose: “initializing a counter to a predetermined value; incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed,” as required by claim 9. Rather, according to paragraph [0074] of Gupta, if an advertisement is rendered, then a time counter since last advertisement is set to 0. Then in paragraph [0078] Gupta measures the amount of time since last advertisement. This is in contrast to incrementing the counter by an amount of time that the plurality of the advertisement messages and the received video data, are output, as claimed. Then in paragraph [0085] Gupta states that when the time between advertisements reaches a threshold, then another advertisement is rendered and the counter is initialized. Gupta does not use duration of advertisement and video output, as claimed, rather Gupta uses duration of time where there are no advertisements. As such, clearly Gupta teaches away from the claimed limitations.

Further, Dimitrova (col. 7, lines 8-19) does not disclose: “decrementing the counter by an amount corresponding to an amount of time that the step of outputting the additional video without outputting the plurality of the advertisement messages is being performed; and when the counter reaches the predetermined value, discontinuing the step of outputting the additional video without outputting the plurality of the advertisement messages,” as claimed.

Indeed, in col. 7, lines 8-19, Dimitrova states: “The above-noted counter for the signatures on a found commercial list can be monitored to determine how frequently it is incremented, and the results used to provide further commercial identification information. For example, if the counter is incremented within a relatively short period of time, on the order of about 1-5 minutes, it is probably not a commercial. As another example, if the counter is *not* incremented for a very long time, e.g., on the order of a week or more, then the counter may be decremented, such that the commercial is eventually ‘forgotten’ by the system. This type of temporal relationship policy can also be implemented for the signatures on the above-noted probable lists.” Therefore, the counter referenced in Dimitrova is a commercial frequency counter (col. 6, lines 64-66), and not a commercial time counter, as claimed. Further, in Dimitrova there is *no* mention whatsoever of decrementing a time counter, as claimed (in Dimitrova the commercial frequency counter is decremented if it has not been incremented for a very long time). The Examiner’s interpretation of Applicant’s statement (on page 18 of the response to the Office Action of March 24, 2006) as having stated otherwise, are respectfully traversed since no such admission constituting prior art was made. There was simply a typographical error on page 18 of the response to the Office Action of March 24, 2006 where the

word “no” was missing from the phrase “... there is [no] mention whatsoever of decrementing a time counter, as claimed”. Indeed, the context of the Applicant’s statement therein show that there was simply a typographical error where the word “no” was missing, rather than admission of prior art by Applicant. Applicant reserves the right to provide further arguments/evidence to address this point if the Examiner is not satisfied.

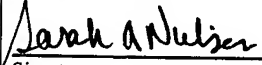
Further, there is no step in Dimitrova when the counter reaches the predetermined value, discontinuing the step of outputting the additional video without outputting the plurality of the advertisement messages, as claimed. On page 19 of the Office Action (third full paragraph), the Examiner has relied on Kim in rejection of Claim 9. For least the reasons discussed above, Kim does not disclose the claimed limitations. As such, one of ordinary skill in the art will not look to Gupta, Dimitrova and/or Kim for achieving the limitations. For at least these reasons, it is respectfully submitted that rejection of Claim 9, and all claims dependent therefrom (Claims 10 and 11), should be withdrawn.

Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Kim, and further in view of Gupta, and further in View of Dimitrova. Rejection of Claims 14 under 35 U.S.C. 103(a) is respectfully traversed because for at least the reasons provided in relation to claims 1, 5, 9 and 12, the references, alone or in combination, do not disclose all of the claimed limitations.

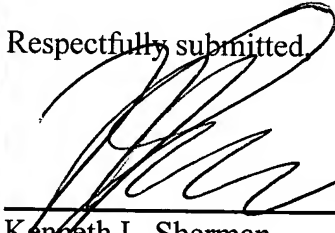
If any of the claims are again rejected, Applicant reserves the right to provide further arguments/evidence in support of allowance of the claims.

**CONCLUSION**

For these and other reasons, it is respectfully submitted that the rejection of the rejected claims should be withdrawn, and all of the claims be allowed. Accordingly, reexamination, reconsideration and allowance of all the claims are respectfully requested.

<b>CERTIFICATE OF MAILING</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December <u>13</u> , 2006.	
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	Signature

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